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10/577,208	01/26/2007	Steven J. Mastrianni	YOR920030470US1	3304

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EXAMINER
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DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3682

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,208	<b>Applicant(s)</b> MASTRIANNI ET AL.	
	<b>Examiner</b> ARTHUR DURAN	<b>Art Unit</b> 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2011.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 29-35 have been examined.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (20030117635).

Claim 29. Roberts discloses a method for facilitating distribution of coupons for use at at least one store, comprising:

creating a targeted coupon by at least one coupon associate taken from a group of coupon associates consisting of: a particular store; a chain store; a customer environment sensor; a weather sensor; a product manufacturer; a product manufacturer; a service provider; a government agency; a first user; at least one other user; an employer of a first user; a third party agent; a software agent; and any combination of these associates (Figs. 1, 9);

providing a coupon device to a first user, from one of a group of coupon providers consisting of: the Coupon Service Bureau; said at least one store; a product manufacturer; a service provider; a government agency; a family member; an employer of said first user (Figs. 1, 8, 12);

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said first user employing the coupon device, comprising a device taken from a group of devices consisting of: a handheld device; a computing device; a smart card; a PDA; and a cell phone (Figs. 1, 8, 12); and any combination of these devices, to make a request to a coupon service bureau to obtain a targeted coupon for a targeted advantage (Figs. 1, 9, 7), wherein the targeted advantage is taken from a group of targeted advantages consisting of: product discount; service discount; duration of discount; rebate; service feature; service contract feature; product feature; ecological feature; safety feature; preferred instructions; an independent software agent; and any combination of these advantages (Figs. 3, 5, 9); and

a coupon service bureau performing steps of:

forwarding said targeted coupon to said first user (Fig. 1);

metering at least one of quantity of user requests, nature of user requests, quantity of coupon service bureau forwardings, and nature of coupon service bureau forwardings (Figs. 2, 9, 10); and

billing at least one of said first user or a coupon associate ([10, 13]);

and wherein said coupon service bureau performs at least one of the following additional steps:

modifying said targeted coupon based on a coupon- modifying criterion taken from a group of criteria consisting of: expiration date; number of other users using targeted coupons; current weather; predicted weather; news reports; movies; movie show times; user's buying history; stores record of sales; time of day; number of sales for that day; speed at which product is selling; prevailing market conditions; geopolitical

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events; fuel prices; demographic information; traffic patterns; gas prices; prevailing economic conditions; number of people in store at the moment or predicted to be in the store; time of day; terrorist alert level; nature of stores along the way to destination store; historical record of traffic problems; historical record of accidents; crime statistics; and any combination of these criteria (Figs. 3, "variable coupon data fields"; Figs 3, 9, 10);

deleting the targeted coupon ([40, 54]);

graphically modifying the targeted coupon; changing the targeted coupon value (Figs. 5; [40, 54] ); and

moving the targeted coupon from one location to another (Figs. 1, 8, 12).

Roberts does not explicitly disclose billing at least one of said first user or a coupon associate according to the number and nature of requests or forwardings. However, Roberts discloses that it is obvious, old and well known that there are costs per coupon distributed or redeemed ([10, 13]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Roberts can bill for the coupons distributed or redeemed. One would have been motivated to do this in order to better cover the costs associated with coupon distribution and redemption.

Additionally, On 5/16/11, Applicant did not amend the claims at all. Rather, Applicant presented arguments.

On page 10 of the Remarks dated 5/16/11, Applicant states:

“The Roberts patent publication does not teach or suggest a user coupon device for requesting, receiving and redeeming electronic versions of coupons, which is expressly recited in independent Claim 29, and is accordingly a claim feature of each of dependent claims 30-35.

... Since the Roberts patent publication neither teaches nor suggests method steps of providing a coupon device to a user or steps for using the coupon device for requesting, receiving and redeeming electronic coupons, it cannot be concluded that Roberts obviates the invention as set forth in independent Claim 29 and in all claims that depend therefrom and add further limitations thereto.”

However, Roberts discloses a user device and also a variety of user devices (Fig. 1, item 6, “personal computer”; Fig. 8, item 6, “remote computer”; Fig. 12, item 114, “remote user station”; “[30]... may be used on coupons that are electronically downloaded by a consumer from a centralized source to a personal computer, wireless handheld device, mobile phone, PDA, kiosk or other terminal device”). And, this user device can request, receive, and redeem electronic versions of coupons (Figs. 1, 7, 8, 12). Further note that Roberts explicitly discloses electronic redemption of electronic coupons:

“[50]... Alternatively, the system may enable the user to transmit electronically the printable coupon data from the coupon output buffer to the centrally located repository or directly to the retailer for electronic coupon redemption.

[106]... In the alternative, the coupon may be redeemed electronically by sending the coupon data in the output buffer via the data communications interface 20 back to the online service provider 2. This is especially useful in the "electronic shopping mall" environment now found in many online services. The electronic coupon data could also be routed via the data communications interface 20 to a retail store where the user will be shopping, where the coupon data is held in a buffer pending purchase by the user of the matching product."

Hence, Roberts discloses a user device and requesting, receiving, and redeeming electronic versions of coupons.

And, in regards to the "providing a coupon device to a user" features, Examiner notes that how, when, or where the device is provided to the user is open to interpretation as this is not stated in the claims. The providing is not distinguished as selling or lending or letting use so "providing" can be interpreted as any of these. The claims state that the device can be a wide variety of devices including a device as broad as "a computing device". The claims state that the device can be provided by a store, a product manufacturer, a service provider, a family member, etc. And, since Roberts discloses that the user has and uses a user device that can be a personal computer, remote computer, remote user station, wireless handheld device, mobile phone, PDA, kiosk or other terminal device, the user has to have received this device. That is, users are not born with user devices. Users receive user devices from somewhere. And, without further distinguishing in the claim, all of these devices are provided by a product manufacturer or service provider. That is, for example, a maker of a product is a

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product manufacturer and they provide devices to users. Also, the store provided a kiosk, remote user station, or other terminal device to a user ([127]). Also, a family member, government agency, or employer provide these devices to users via gift, loans, device borrowing, or permitting use for work. Hence, the claims do not state how, when, where or with what limitations a device is provided to a user. And, since the claims state that a variety of parties can provide a device and that a variety of devices is possible, the claim features can be interpreted broadly. And, as shown above, Roberts discloses a variety of user devices being used by users. And, since users are not born with user devices, users must receive the devices from somewhere. Hence, it is intrinsic or implicit that Roberts' users with a variety of user devices received the device from a product manufacturer, service provider, store, government agency, family member, or employer.

Hence, Roberts renders obvious the features of the Applicant's claims.

Also, Examiner notes that the various types of providers, as presently written in the claims, can be interpreted as nonfunctional descriptive material. It makes not difference to the functions of the claim whether a product manufacturer or family member or employer provided a user device. Nothing is performed differently depending on which party provides the computer. Hence, it is nonfunctional as to which provider provides the user device (see MPEP 2106.01).

Claim 30. Roberts further discloses the method as recited in claim 29, further comprising obtaining user-specific information from said first user, wherein the user-specific information includes at least one piece of information taken from a group of



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information comprising: first user demographic information; time of day of the step of making; time of day of the step of employing; product information; rate of purchases in a given time for a given product or products; and user's age; gender; income; place of residence; marital status; number of family members; past buying habits; level of education; hobbies; race; religion; and any combination of these pieces of information (Figs. 6, 9, 10; [84, 86, 95] demographic information; [110-118] using purchase and coupon use information for targeting).

Claim 31. Roberts further discloses the method as recited in claim 29, further comprising said first user employing said coupon to obtain said targeted advantage at at least one store (Fig. 1).

Claims 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts (20030117635) in view of Narayan (20020138348).

Claim 32. Roberts further discloses the method as recited in claim 29, further comprising a further step taken from a group of further steps consisting of:  
at least one associate from said group of coupon associates monitoring and storing usage of said targeted coupon;  
at least one coupon associate receiving targeted coupon use data from at least one other coupon associate from said group of targeted coupon associates;  
said at least one coupon associate redeeming said targeted coupon after use of said targeted coupon by said first user (Figs. 1, 2, 6, 9, 10); one of said at least one coupon associate providing an identifier (Figs 1, 3, 5, 9, user id bar code).

Roberts does not explicitly disclose one of said at least one coupon associate providing an identifier enabling use of said targeted coupon by a limited user population. However, Narayan discloses a coupon exchange where members can trade, barter, sell, auction, etc coupons to other members ([11, 13, 172]; Fig. 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Narayan's coupon exchange to Robert's coupon members and coupon providing and coupon distribution. One would have been motivated to do this in order to better and allow coupon providing and coupon distribution.

Claim 33. Roberts does not explicitly disclose wherein the step of forwarding includes at least one of: requiring a return of a previous coupon from said first user to the Coupon Service Bureau, and another user providing said targeted coupon to said Coupon Service Bureau in exchange for a previous coupon held by said first user.

However, Roberts discloses data and information exchange ([53, 54, 78]). And, Narayan discloses a coupon exchange where members can trade, barter, sell, auction, etc coupons to other members ([11, 13, 172]; Fig. 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Narayan's coupon exchange to Robert's coupon members and coupon providing and coupon distribution. One would have been motivated to do this in order to better and allow coupon providing and coupon distribution.

Claim 34. Roberts does not explicitly disclose wherein a coupon exchange provided by said computer service bureau permits user exchange of coupons, said exchange comprising one of barter, sale, auction, and any combination of these

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techniques. However, Roberts discloses data and information exchange ([53, 54, 78]). And, Narayan discloses a coupon exchange where members can trade, barter, sell, auction, etc coupons to other members ([11, 13, 172]; Fig. 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Narayan's coupon exchange to Robert's coupon members and coupon providing and coupon distribution. One would have been motivated to do this in order to better and allow coupon providing and coupon distribution.

Claim 35. Roberts further discloses the method as recited in claim 34, wherein the electronic exchange is restricted by a restriction taken from a group of restrictions consisting of: time limitations, location of a store limitations, location of exchangers of electronic coupons limitations, product limitations, and price limitations ([3, 6, 23, 40, 43, 54, 55, 82, 105-109, 111, 123, 138], expiration of coupon which functions as time limitations).

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are not found persuasive.

On 5/16/11, Applicant did not amend the claims at all. Rather, Applicant presented arguments.

On page 10 of the Remarks dated 5/16/11, Applicant states:

"The Roberts patent publication does not teach or suggest a user coupon device for requesting, receiving and redeeming electronic versions of coupons, which is

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expressly recited in independent Claim 29, and is accordingly a claim feature of each of dependent claims 30-35.

... Since the Roberts patent publication neither teaches nor suggests method steps of providing a coupon device to a user or steps for using the coupon device for requesting, receiving and redeeming electronic coupons, it cannot be concluded that Roberts obviates the invention as set forth in independent Claim 29 and in all claims that depend therefrom and add further limitations thereto."

However, Roberts discloses a user device and also a variety of user devices (Fig. 1, item 6, "personal computer"; Fig. 8, item 6, "remote computer"; Fig. 12, item 114, "remote user station"; "[30]... may be used on coupons that are electronically downloaded by a consumer from a centralized source to a personal computer, wireless handheld device, mobile phone, PDA, kiosk or other terminal device"). And, this user device can request, receive, and redeem electronic versions of coupons (Figs. 1, 7, 8, 12). Further note that Roberts explicitly discloses electronic redemption of electronic coupons:

"[50]... Alternatively, the system may enable the user to transmit electronically the printable coupon data from the coupon output buffer to the centrally located repository or directly to the retailer for electronic coupon redemption.

[106]... In the alternative, the coupon may be redeemed electronically by sending the coupon data in the output buffer via the data communications interface 20 back to the online service provider 2. This is especially useful in the "electronic shopping mall"

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environment now found in many online services. The electronic coupon data could also be routed via the data communications interface 20 to a retail store where the user will be shopping, where the coupon data is held in a buffer pending purchase by the user of the matching product.”

Hence, Roberts discloses a user device and requesting, receiving, and redeeming electronic versions of coupons.

Also, the following is in regards to the “providing a coupon device to a user”. Examiner notes that it is the Applicant’s claims as stated in the Applicant’s claims that are being rejected with the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In interpreting claim language, the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art is applied, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description. See *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). See also *In ream. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) and *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983). Claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000). It is Appellant’s burden to precisely define the invention. See *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997).

And, in regards to the “providing a coupon device to a user” features, Examiner notes that how, when, or where the device is provided to the user is open to

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interpretation as this is not stated in the claims. The providing is not distinguished as selling or lending or letting use so "providing" can be interpreted as any of these. The claims state that the device can be a wide variety of devices including a device as broad as "a computing device". The claims state that the device can be provided by a store, a product manufacturer, a service provider, a family member, etc. And, since Roberts discloses that the user has and uses a user device that can be a personal computer, remote computer, remote user station, wireless handheld device, mobile phone, PDA, kiosk or other terminal device, the user has to have received this device. That is, users are not born with user devices. Users receive user devices from somewhere. And, without further distinguishing in the claim, all of these devices are provided by a product manufacturer or service provider. That is, for example, a maker of a product is a product manufacturer and they provide devices to users. Also, the store provided a kiosk, remote user station, or other terminal device to a user ([127]). Also, a family member, government agency, or employer provide these devices to users via gift, loans, device borrowing, or permitting use for work. Hence, the claims do not state how, when, where or with what limitations a device is provided to a user. And, since the claims state that a variety of parties can provide a device and that a variety of devices is possible, the claim features can be interpreted broadly. And, as shown above, Roberts discloses a variety of user devices being used by users. And, since users are not born with user devices, users must receive the devices from somewhere. Hence, it is intrinsic or implicit that Roberts' users with a variety of user devices received the device

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from a product manufacturer, service provider, store, government agency, family member, or employer.

Hence, Roberts renders obvious the features of the Applicant's claims.

Also, Examiner notes that the various types of providers, as presently written in the claims, can be interpreted as nonfunctional descriptive material. It makes not difference to the functions of the claim whether a product manufacturer or family member or employer provided a user device. Nothing is performed differently depending on which party provides the computer. Hence, it is nonfunctional as to which provider provides the user device (see MPEP 2106.01).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to ARTHUR DURAN whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Namrata Boveja can be reached on (571) 272-8105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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6/7/2011